

<b>Notice of Allowability</b>	Application No.	Applicant(s)	
	10/521,137	WALLACE, OWEN BRENDAN	
	Examiner	Art Unit	
	Niloofer Rahmani	1625	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--**

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 01/12/2005.
2. ☒ The allowed claim(s) is/are 1-18.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☐ All    b) ☐ Some\*    c) ☐ None    of the:
  1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.  
**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS ( as "replacement sheets") must be submitted.
  - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review ( PTO-948) attached
    - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
  - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

- |  |  |
|--|--|
| 1. <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)                                    |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 6. <input checked="" type="checkbox"/> Interview Summary (PTO-413),<br>Paper No./Mail Date <u>12/16/2005</u> . |
| 3. <input checked="" type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),<br>Paper No./Mail Date <u>01/12/2005</u> | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment  |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit<br>of Biological Material                                 | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance                           |
|  | 9. <input type="checkbox"/> Other _____.   |

### **DETAILED ACTION**

1. Claims 1-18, and 31-36 are currently pending in the instant application. Claims 19-30 are cancelled.

### **2. EXAMINER'S AMENDMENT**

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Gilbert T. Voy on 01/18/2006.

The application has been amended as follows:

**DELETE** claims 31-36.

### **3. REASON FOR ALLOWANCE**

The closest prior art for claims 1-18 is EP 0761669. The difference is that the prior art has six-member ring in four fused rings instead of seven-member ring in the instant case. Therefore, the claims are free of prior art.

Claims 31-36 were deleted without prejudice to the filing of a divisional application due to a restriction, see below.

### **4. Election/Restrictions**

Restriction is required under 35 U.S.C. 121 and 372.

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This application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

- I. Claims 1-18, drawn to compounds, and pharmaceutical compositions of formula (I), classified in class 540, subclass various depending on species election. If this group is elected, a further election of a single disclosed species is also required.
- II. Claims 31-32, drawn to compounds of formula (4), classified in class 546, 548, 549, subclass various, depending on species election. If this group is elected, further election of a single disclosed species is also required.
- III. Claims 33-34, drawn to compounds of formula (10), classified in class 546, 548, 549, subclass various depending on species election. If this group is elected, further election of a single disclosed species is also required.
- IV. Claims 35-36, drawn to compounds of formula (11), classified in class 546, 548, 549, subclass various depending on species election. If this group is elected, further election of a single disclosed species is also required.

Groups I-VI compounds are independent and distinct because the structure of each group differ in elements, bonding arrangement and chemical properties to such an extend that a reference anticipating any one group among I-II would not necessarily render the other groups obvious. The search for each group is not coextensive of the others and separate search and examination must be conducted. Without restriction, a tremendous burden would be imposed on the office to search such diversified subject matter.

During a telephone conversation with Gilbert T. Voy on 12/16/2005 a provisional election was made without traverse to prosecute the invention of group I, claims 1-18. Affirmation of this election must be made by applicant in replying to this Office action. Claims 31-36 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

**5. Priority**

This application is a 371 of PCT/US03/19554, filed on 07/11/2003,  
which claims benefit of 60/398,538, filed on 07/24/2002.

**6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Niloofar**

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Rahmani whose telephone number is 571-272-4329. The examiner can normally be reached on Monday through Friday from 8:30 am to 5:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang, can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NILOOFAR RAHMANI

01/19/2006

NL



D. MARGARET SEAMAN

PRIMARY EXAMINER

GROUP 1625